

REMARKS

Claims 1, 2, 4, 5, 7-11, 14, 15, and 17-21 are pending and stand rejected. Claims 6, 12, 13, and 16 are canceled without prejudice or disclaimer. Claims 1, 7-11, 14, 15, and 17-21 are amended above. Applicant submits that the foregoing amendments place the application in condition for allowance or, in the alternative, in better condition for appeal, and accordingly respectfully requests entry of these amendments. The following remarks are believed to be fully responsive to the Office Action. No new matter is added herein.

Clerical Amendments

Claims 7-10 have been amended to depend from independent claim 1 rather than canceled claim 6, the subject matter of which has been incorporated into independent claim 1. Claim 14 has been similarly amended to depend from independent claim 11 rather than canceled claim 12.

Claims 17-21 have been amended to correct typographical errors and for consistency of terminology.

Rejection Under 35 U.S.C. § 102(b)

The Examiner rejects claims 1, 6, 7, and 10 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,778,689 to Beatenbough ("Beatenbough"). To anticipate a claim, a single prior art reference must expressly or inherently disclose each and every element of the claimed invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). The rejection as to claim 6 is moot in view of its cancellation. As to claims 1, 7, and 10, the Applicant respectfully submits that Beatenbough fails to meet this standard.

Claim 1 recites "a sensor assembly unit configured to output at least a calculated value and a measured value" and a control unit that activates a heating unit "when the surface temperature is less than or equal to the calculated value" and that deactivates the heating unit "when the surface temperature attains the measured value." That is, the instant invention activates and deactivates supplemental heat in response to a comparison between the surface

temperature of the refrigerator or freezer and measured and calculated environmental variables. See Figure 3 and accompanying description at paragraphs 0027 – 0031. In contrast to the present invention, however, Beatenbough does not compare calculated and measured values to a surface temperature in order to control the activation and deactivation of a heating unit. Rather, Beatenbough utilizes *only* the calculated dew point in connection with predetermined, user-selected dew point and active pulse duration limits to control the active width of an electrical pulse. Beatenbough, col. 4, lines 16-41. Since Beatenbough fails to teach each and every element of claim 1, the rejection is respectfully requested to be withdrawn.

Claims 6, 7, and 10 depend from claim 1 and therefore incorporate all limitations thereof. Applicant accordingly respectfully requests withdrawal of the Examiner's rejection of these claims for at least the reasons specified above.

Rejections Under 35 U.S.C. § 103(a)

Claims 2 and 11-21

The Examiner rejects claims 2 and 11-21 under 35 U.S.C. § 103 as obvious over Beatenbough in view of U.S. Patent No. 4,260,876 to Hochheiser ("Hochheiser"). To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach each and every claimed limitation. MPEP § 2142. The rejections of claims 12, 13, and 16 are moot in view of their cancellation above. Applicant respectfully traverses the remaining rejections.

As described above, Beatenbough does not teach each and every element recited in claim 1. The Examiner relies on Hochheiser only to teach a surface temperature sensor, and does not assert that Hochheiser overcomes the deficiencies of Beatenbough with respect to claim 1. Since claim 2 depends from claim 1, the asserted combination of references fails to disclose each and every element of claim 2.

Furthermore, there is no motivation for the asserted combination of references. The mere fact that references *can* be combined is insufficient; the prior art must also suggest the *desirability* of the combination. MPEP § 2143.01. As described above, the *only* environmental variable important to the operation of Beatenbough is the dew point; the surface temperature of

the refrigerator, or any other environmental variable, is utterly irrelevant to Beatenbough's operation. Beatenbough does not concern itself with the differential between the refrigerator surface temperature and the dew point of the ambient air. Thus, addition of a surface temperature sensor to the system of Beatenbough, though possible, would be pointless. For at least the foregoing reasons, the asserted combination of references fails to establish a *prima facie* case of obviousness as to claim 2. Applicant accordingly requests that the Examiner withdrawal the rejection of claim 2.

Claim 11 recites

(e) making a first determination of whether the first surface temperature measurement is at a first acceptable level relative to the dew point;

(f) activating a heating unit if the first determination is not at the first acceptable level;

...

(i) making a second determination of whether the second surface temperature measurement is at a second acceptable level relative to the second ambient temperature measurement; and

(j) deactivating the heating unit if the second determination is at the second acceptable level.

Claim 15 recites

means for making a first determination of whether the first cabinet surface temperature measurement is at a first acceptable level relative to the dew point;

means for activating a heating unit if the first determination is not at the first acceptable level;

...

means for making a second determination of whether the second cabinet surface temperature is at a second acceptable level relative to the second ambient temperature measurement; and

means for deactivating the heating unit if the second determination is at the second acceptable level.

In light of the arguments made above with respect to claim 1, Applicant submits that Beatenbough alone teaches neither the steps of nor means for activating and deactivating a heating unit in response to a comparison of the cabinet surface temperature with any other environmental variable. In light of the arguments made with respect to claim 2, Applicant

further submits that the combination of Hochheiser with Beatenbough would not overcome these deficiencies *even if* motivation existed to combine the references, which it does not.

Accordingly, claims 11 and 15 are not *prima facie* obvious, and Applicant requests that the Examiner withdrawal his rejection of those claims.

Claim 14 depends from claim 11, while claims 17-21 depend from claim 15. Applicant accordingly respectfully requests withdrawal of the Examiner's rejection of these claims for at least the reasons specified above.

Claims 4 and 5

The Examiner rejects claims 4 and 5 under 35 U.S.C. § 103 as obvious over Beatenbough in view of Official Notice. Since the Official Notice does not address the subject matter lacking in Beatenbough, as discussed above, the Official Notice does not cure the deficiencies of Beatenbough with respect to claim 1. Consequently, the asserted combination does not teach each and every element of claim 1. Since claims 4 and 5 depend from claim 1, Applicant respectfully requests withdrawal of this rejection for at least these reasons.

Claims 8 and 9

The Examiner rejects claims 8 and 9 under 35 U.S.C. § 103 as obvious over Beatenbough in view of U.S. Patent No. 4,389,856 to Ibrahim ("Ibrahim"). As discussed at length above, Beatenbough fails to teach each and every element of claim 1. The Examiner does not contend that Ibrahim overcomes these deficiencies, relying on Ibrahim solely to teach the use of an electromechanical valve for conveying heated gases to reduce moisture buildup on glass doors. Thus, the combination of Ibrahim and Beatenbough does not teach each and every element of the claimed invention, and therefore fails to establish a *prima facie* case of obviousness of claims 8 and 9. For at least these reasons, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicant believes that a one month extension of time is necessary for this paper to be considered timely filed, and hereby petitions for such extension under 37 C.F.R. § 1.136. A check in the amount of \$120 is enclosed. In the event further extensions of time are required for this paper to be considered timely, Applicant hereby makes a conditional petition for any necessary further extensions. Please charge any fee deficiencies in fees and credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87334.6040.

Respectfully submitted,

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